

REMARKS

Claims 1, 2, 4-19 and 21-25 currently are pending. Claim 1 currently has been amended.

35 USC § 112, second paragraph

The examiner rejected claims 23-25 under 35 USC 112, second paragraph, as being indefinite in the use of the phrase "active substance." The examiner believes it is not known which chemicals are considered to be "active substances."

Applicants refer the examiner to page 3, lines 12-17 of the instant specification. In light of this portion of the specification applicants believe the phrase "active substance" should be clear to one of ordinary skill in the art. Determining whether a claim is definite requires an analysis of whether one skilled in the art would understand the bounds of the claim when read in light of the specification. If the claims read in light of the specification reasonably apprise those skilled in the art of the scope of the invention, § 112 demands no more. *Miles Lab., Inc. v. Shandon, Inc.*, 997 F.2d 870, 875, 27 U.S.P.Q.2D 1123, 1126 (Fed. Cir. 1993).

In view of the above, the rejection of claims 23-25 under 35 USC § 112, second paragraph should be withdrawn.

35 USC § 103

Claims 1, 2, 4-19, 21, 23-25 are rejected under 35 USC § 103(a) as being unpatentable over van Ooijen or Gonthier et al in view of Kotani et al. Claim 22 is rejected under 35 USC 103(a) as being unpatentable over van Ooijen, in view of Kotani et al., and further in view of Gonthier et al.

Of preliminary note, applicants assume the examiner refers to van Ooijen (EP 0 608 975

A) and not GB 0 608 975A, as the latter applies to a new edge binding machine.

To establish *prima facie* obviousness, the examiner must show in the prior art some suggestion or motivation to make the claimed invention, a reasonable expectation for success in doing so, and a teaching or suggestion of each claim element (*see, e.g., In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ 2d 1941 (Fed. Cir. 1992); *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986); *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)).

The examiner has not met the above requirements for making a *prima facie* obviousness showing. Applicants therefore traverse the rejection.

The issue is whether the cited references teach or suggest each and every element of the rejected claims.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). In the present case, van Ooijen or Gonthier et al in view of Kotani et al do not teach or suggest each and every element of claims 1, 2, 4-19, 21, 23-25 and van Ooijen in view of Kotani et al., and further in view of Gonthier et al. do not teach or suggest each and every element of claim 22.

Presently amended claim 1 now is directed to impregnated salts with a particle size of 10 μm to 2000 μm comprising at least one salt of one or more carboxylic acids, which salt has been impregnated with from 0.5 to 30% by weight, based on the carboxylic acid salt, of at least one carboxylic acid that is liquid or becomes liquid at a temperature of 40 °C or below.

Applicants' composition is a solid which has good storage, flow and processing properties. Van Ooijen or Gonthier et al in view of Kotani et al and van Ooijen or Gonthier et al, in view of Kotani et al., and further in view of Gonthier et al do not teach or suggest this feature.

Van Ooijen teaches a **liquid** composition of a mixture of hydroxyl carboxylic acid and a carboxylic acid. Gonthier et al. teach a method of preserving fish to inhibit their degradation in which the disclosed compositions are **liquid** compositions. In this regard, Gonthier et al. teaches in column 1 (lines 52ff): "The new compositions according to the invention are mixtures of a buffered mixture of propionic acid/metal propionate and of a buffered mixture of benzoic acid/metal benzoate the total pH of which is lower than 7 and preferably between 4 and 5." One of ordinary skill in the art knows that buffered systems are always in **liquid** form. Further support for applicants' argument is found in column 2 (lines 49-53) and in example 1 (column 3, lines 10-42), which show that the used mixtures are mixtures of 95 parts by **volume** of the buffered propionic acid/sodium propionate of pH 4.5 and 5 parts by **volume** of the buffered benzoic acid/sodium benzoate of pH 4.5.

The product of Kotani et al. is a mixture of alcohol and a carboxylic acid. Kotani et al. teach a sorbic acid composition which is produced by blending sorbic acid with a specific amount of glycerin (column 1, lines 55 to 57). The blending of the sorbic acid with glycerin is carried out by soaking with a polyhydric alcohol. Therefore, the taught mixture is not a solid.

As show above, the references, taken individually or when combined, do not teach this element of the presently rejected claims.

For the reasons expressed above, it is urged that the prior art references cited by the

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examiner either singly or in combination fail to anticipate or suggest the present invention as defined by the amended claims. Accordingly, a *prima facie* case of obviousness has not been established by the examiner and the rejection under 35 USC § 103 should be withdrawn.

Applicants herein request a one month extension of time. Fee is submitted by the enclosed USPTO credit card form.

Please charge any shortage in fees due in connection with the filing of this paper, including Extension of Time fees to Deposit Account No. 14-1437.

Please credit any excess fees to such deposit account.

Respectfully submitted,

NOVAK DRUCE DeLUCA & QUIGG, LLP

A handwritten signature in black ink, appearing to read 'Daniel S. Kim', with a stylized flourish at the end.

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